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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,627	12/09/2003	Frank E. Oetlinger	599.016	4758
23598	7590	09/20/2005		
BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C. 250 E. WISCONSIN AVENUE SUITE 1030 MILWAUKEE, WI 53202				
			EXAMINER HAMILTON, ISAAC N	
			ART UNIT 3724	PAPER NUMBER

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/731,627

Applicant(s)

OETLINGER ET AL.

Examiner

Isaac N. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 22-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 10, 12, 13, 15 and 19-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Inventions I and II, claims 1-21, in the reply filed on 07/05/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Applicant traversed an election between Inventions I and II, however, there was no requirement for election between these inventions.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 10. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Appropriate correction is required.

### ***Specification***

3. The disclosure is objected to because of the following informalities: page 8, line 17, "described" should be changed to --describe--.

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Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 14-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "the insert receiving structure" in line 6. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 6, 7, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernstein (6,019,358). Bernstein discloses elongated insert receiving element 16 on the right side of figure 2; cavity juxtaposed elements 42 and 34 on the insert receiving element in figure 2; blanking tool insert 28; clamp piece 16 in the center of figure 2; outer frame 12; outer face 26; inner face is the bottom surface opposite to face 26 in figure 4; bore 40, 62, 43; jaw element 48; clamping cavity juxtaposed elements 48 and 16; clamping position shown in figure 2; release position shown in figure 4; screw member 60; acute angle shown in figures 2 and 4 is 65 degrees.

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8. Claims 1-6, 11, 14, 16, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Robinson (2,354,976). Robinson discloses elongated insert receiving element 14, 18, 20; elongated insert retaining structure 14, 18, 29; cavity is inside the “hook” portion of element 14, 18, 20; the cavity is capable of receiving a blanking tool insert; clamp piece 30; plate member 30; inner face is juxtaposed element D and element 30; outer face is juxtaposed elements 30 and 18; element 24 passes through the bore of element 30; jaw element/clamping structure C; clamping cavity is juxtaposed elements 30 and C; release position and clamping position are inherent because bolt when bolt 24 is unfastened the jaw element is released, and when it is fastened it is clamping; first clamping surface 33, 36; second clamping surface 35, 38; first and second clamping portion are arcuate and have an apex as shown in figure 5; screw member/fastening element 24; slot 44.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. To the degree it can be argued that the acute angle is not in the range of 30 and 80 degrees, claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein. Bernstein discloses the claimed invention except for an acute angle in the range of 30 and 80 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the acute angle in the range of 30 and 80 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering

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the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ

233. It would have been obvious to provide the acute angle in the range of 30 and 80 degrees in order to create leverage for the weight of the elements.

11. To the degree it can be argued that the acute angle is not 65 degrees, claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein. Bernstein discloses the claimed invention except for an acute angle of 65 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the acute angle 65 degrees, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It would have been obvious to provide an acute angle of 65 degrees in order to create leverage for the weight of the elements.

#### ***Allowable Subject Matter***

12. Claims 10, 12, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The references teach everything as noted above, but do not teach a lip, a jogger, or a pin-receiving depression. It would not have been obvious to combine other prior art teachings with the references in order to meet the claim limitations.

13. Claims 15, 19, 20 and 21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. The references teach everything as noted above, but do not teach a lip, a jogger, or an acute angle. It would not have been obvious to combine other prior art teachings with the references in order to meet the claim limitations.

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***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thompson is cited for a blanking tool connected to an outer frame using an insert receiving element, a clamp piece, and a jaw element.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



IH

September 16, 2005



Allan N. Shoap  
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